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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
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In re Application of :
MOORE et al :
Serial No.: 09/365,576 : Decision on Petition
Filing Date: 2 August 1999 :
Attorney Docket No. 1944 :

This letter is in response to the Petition to withdraw finality, filed with a certificate of mailing date of 23 October 2003.

BACKGROUND

The petition concerns the finality of the rejection of claims under 35 USC 102(e).

A review of the file history shows that the claims were first rejected under 35 USC 102(e) as being anticipated by Liao et al (U.S. Patent No. 5,639,616) on 28 June 2001. Applicants responded with arguments and a Declaration by Dr. Moore on 28 December 2001. The rejection was maintained and made final on 23 April 2002, without acknowledgement of or consideration of the first Dr. Moore declaration. Applicants then filed a Notice of Appeal on 29 October 2002 concurrent with the filing of arguments and a second Declaration of Dr. Moore, which presents additional documentation of the sequencing of the RIP15 prior to the filing date of Liao. On 24 March 2003, applicants filed their Appeal Brief and again argued that Liao cannot be considered prior art because the instant invention was reduced to practice prior to Liao's earliest filing date.

On 30 June 2003, the Examiner prepared an Advisory Action, stating that the request for reconsideration has been considered but does not place the application in condition for allowance, as follows.

In regard to the 102(e) rejection as being anticipated by Liao et al, the Declaration of Dr. Moore filed 28 December 2001 does not overcome the rejection because applicant did not provide a showing under 37 CFR 1.608(b). See MPEP 2308.02.

An Examiner's Answer has not yet been prepared.

DISCUSSION

The application, file history and petition have been considered carefully.

The petition argues that the Office's requirement for a showing under 37 CFR 1.608(b) was first raised in its advisory action mailed 30 June 2003. To properly raise this issue, the petition goes on, the finality of the rejection must be withdrawn in order to apply the new ground of rejection concerning the showing under 37 CFR 1.608(b).

MPEP 706.02(b) provides applicants with five ways to overcome a rejection under 35 USC 102(e): (1) persuasive argument, (2) amendment of the claims to distinguish over prior art (3) filing a declaration or affidavit under 37 CFR 1.132 showing the reference invention is not by another (4) filing an affidavit or declaration under 37 CFR 1.131 showing prior invention or (5) perfecting a claim to priority.

Applicants chose the fourth option and, in support of this position, filed two declarations by Dr. Moore, the first in response to the first action on the merits and the second in response to the Final action. The first declaration filed on 28 December 2001 stated that the RIP15 clone was isolated and sequenced prior to filing of Liao, and supported this assertion with laboratory notebook excerpts. The final Office action does not address this declaration. The second declaration was filed on 23 October 2003 and contains additional sequence information. The Advisory action mailed 30 June 2003 refers to the first declaration but does not mention the second declaration.

Because the statements issued in the advisory action concerning 1.608 (b) showing arose from and related to applicants' response to the first action on the merits, these statements should have been made in the second Office action. As such, the second action was incomplete and its' finality premature.

DECISION

The petition is **GRANTED** for the reasons set forth above. Finality of the Office action mailed 23 April 2002 has been withdrawn. The application will be forwarded to the

examiner for consideration of the amendment filed 29 October 2002 as a proper reply to a non-Final Office action.

The application will be forwarded to Examiner for action consistent with this decision.

Should there be any questions with regard to this letter, please contact Special Program Examiner Julie Burke by letter addressed to the Director, Technology Center 1600, P.O. Box 1450, Alexandria VA, 22313-1450 or by telephone at (703) 308-7553 or by facsimile transmission at (703) 308-7230.


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